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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/574,130

12/18/2006

Mikhail S. Shchepinov

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EXAMINER

SISSON, BRADLEY L

ART UNIT

PAPER NUMBER

1634

MAIL DATE

DELIVERY MODE

09/09/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/574,130	Applicant(s) SHCHEPINOV ET AL.	
	Examiner Bradley L. Sisson	Art Unit 1634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-57 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 2, drawn to a method of sequencing a polynucleotide.

Group II, claim(s) 13-16, drawn to a method of sequencing a polynucleotide.

Group III, claim(s) 15, 17, and 20, drawn to a method of sequencing a polynucleotide.

Group IV, claim(s) 4, 6, and 7, drawn to a method of sequencing a polynucleotide.

Group V, claim(s) 5, drawn to a method of sequencing a polynucleotide.

Group VI, claim(s) 8, drawn to a method of sequencing a polynucleotide.

Group VII, claim(s) 9, 10, 18, 19, 21, and 22, drawn to a method of sequencing a polynucleotide.

Group VIII, claim(s) 23-26, drawn to a method of sequencing a polynucleotide.

Group IX, claim(s) 28, drawn to a method of sequencing a polynucleotide.

Group X, claim(s) 29, drawn to a method of sequencing a polynucleotide.

Group XI, claim(s) 30 and 31, drawn to a method of sequencing a polynucleotide.

Group XII, claim(s) 32, drawn to a method of sequencing a polynucleotide.

Group XIII, claim(s) 33, 34, and 36, drawn to a method of sequencing a polynucleotide.

Group XIV, claim(s) 38-40 and 42-47, drawn to a method of sequencing a polynucleotide.

Group XV, claim(s) 41, drawn to a method of sequencing a polynucleotide.

Group XVI, claim(s) 35, drawn to a method of sequencing a polynucleotide.

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Group XVII, claim(s) 48 and 49, drawn to a method of sequencing a polynucleotide.

Group XVIII, claim(s) 50, drawn to a method of sequencing a polynucleotide.

Group XIX, claim(s) 51 and 52, drawn to a method of sequencing a polynucleotide.

Group XX, claim(s) 53, drawn to a method of sequencing a polynucleotide.

Group XXI, claim(s) 54, drawn to a method of sequencing a polynucleotide.

Group XXII, claim(s) 55, drawn to a method of sequencing a polynucleotide.

Group XXIII, claim(s) 56, drawn to a method of sequencing a polynucleotide.

Group XXIV, claim(s) 57, drawn to a method of sequencing a polynucleotide.

2. The inventions listed as Groups I-XXIV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The inventions are all related through the incorporation of a labeled nucleotide into a primer by action of a polymerase. To a lesser degree, a subset of claims is further linked by use of a fluorescently-labeled nucleotide wherein the label participates in FRET.

3. US Patent Application Publication 2001/0039014 A1 (Bass et al.) disclose at paragraph [0310] the use of any of a variety of labels that are incorporated in a primer extension product, including those used in a sequencing reaction. As disclosed therein, the label can participate in FRET.

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4. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

5. The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

6. In view of the teachings of the prior art of record, the technical feature that joins the claims does not constitute a special technical feature, and thusly, the inventions listed as Groups I-XXIV do not relate to a single general inventive concept.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley L. Sisson whose telephone number is (571) 272-0751. The examiner can normally be reached on 6:30 a.m. to 5 p.m., Monday through Thursday.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, Ph.D. can be reached on (571) 272-0735. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bradley L. Sisson/
Primary Examiner, Art Unit 1634